



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
08/15/2011				
EXAMINER				
CHEEMA, UMAR				
ART UNIT		PAPER NUMBER		
2444				
MAIL DATE		DELIVERY MODE		
08/15/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/765,043

Applicant(s)

MARUYAMA ET AL.

Examiner

UMAR CHEEMA

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed on 05/27/2011. Claims 1-15 are pending with claims 1, 11 and 12 as being independent claims. Claims 1, 11 and 12 have been further amended.

Response to Arguments

2. **Applicant's arguments with respect to claims 1, 11 and 12 have been fully considered but they are not persuasive.**

In the communication field, applicant argues in substance that:

- a. Noda does not teaches or suggests a storage section in which sender email-addresses and mail title are stored in association with each other, as claimed (remarks, pg. 6).
- b. Node fails to disclose or suggest adding to scanned image data the sender e-mail address and the mail title set by the second setting section and transmitting the image data to the recipient address set by a first setting section (remarks, pg. 6-7).

In response to argument [a], examiner respectfully disagrees.

First, applicant should note that:

“although< claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts;

during\ examination the USPTO must give claims their broadest reasonable interpretation >in light of the specification<.). This means that the words of the claim must be given their plain meaning unless **>the plain meaning is inconsistent with< the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)".

Secondly, Noda teaches, when E-MAIL TRANSMISSION is selected, a screen 60 for E-mail transmission address book as shown in FIG. 6 is displayed. If NEW ADDRESSEE REGISTRATION 61 is selected on the E-mail transmission address book screen 60, a new addressee registration screen 70 as shown in FIG. 7 is displayed. With the new addressee registration screen 70, the user may input an E-mail address, an indicated or identification name and other required data, and finally operate COMPLETION OF REGISTRATION 71 to complete the registration of an E-mail addressee. At this time, the registered data are stored at the addressee memory 23b as an E-mail transmission address book, by way of addressee registration control 22 (see Noda: at least Paragraphs (0005-0006, 0013, 0047)). Examiner also noted that applicant's "mail title" is broadly recited, and is not limited by the claim language regarding any specific mechanics. At best, the claimed "mail title" as recited in claims 1, 12 and 13 has the functionality of "description, heading, title, notification, name, registration ID" etc... Examiner submits that any of e-mail registration descriptions (IP address, electronic mail addresses, names, data IDs etc.) all reads on the broad concept of "mail title". For example, the new addressee registration screen 70 as shown in Fig. 7, the user may input an E-mail address, an indicated or identification name (can be considered as "mail titles") and other required data and finally operate completion of registration to complete the registration process

(paragraph (0047)). The breadth of the claim language allows for such a reasonable interpretation. While it may be argued that the reference does not specifically refer to such considerations as "mail title", associated with a sender e-mail as noted above as mail titles would have been reasonably drawn from the disclosure of Noda. "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). See MPEP 2144.01.

In response to argument [b], examiner respectfully disagrees.

Node teaches, adding to scanned image data the sender e-mail address and the mail title set by the second setting section and transmitting the image data to the recipient address set by a first setting section (see Noda: at least paragraphs (0019, 0042-0048), wherein after setting up e-mail address and mail title transmitting image data by means of E-mail transmission and PC transmission upon user selection and by selecting from the selection screen the inputting the information and transmitting it to the selected E-mail transmission or PC transmission). Thus, Noda teach or suggest adding to scanned image data the sender e-mail address and the mail title set by the second setting section and transmitting the image data to the recipient address set by a first setting section, for the reasons set forth.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Noda (US Pub. No. 2003/0128387).

4. **As to claims 1, 11 and 12**, Noda discloses an image data transmitting method of a network scanner device (10) (Fig. 1) which attaches image data to electronic mail and transmits image data through a network (see at least abstract, ¶ (0007), **communication device such as a network scanner and a network facsimile, for transmitting image data through e-mail**) comprising steps of: a reading section for scanning a document to obtain image data (see at least ¶ (0041), Fig. 2, **touch screen panel (20) to obtain data from the data memory (23)**), a first setting section for setting up a recipient address to which the image data is to be transmitted (see at least abstract, ¶ (0013), Fig. 2, **memory (23) stores the ID data of the addresses and addressors and a data selection control output from the memory data of addressees and addressors as candidates of addressees when a user set a addressee to whom the image data is to be sent**), a storage section in which sender e-mail addresses and mail titles are stored in association with each other, said sender e-mail addresses being distinct from a sending station address specifying the network scanner device (see at least ¶¶ (0005, 0006, 0013, 0047), **storing**

users register ID data which may be such as names, IP addresses, electronic mail address, and the like of addressees and addressors which are often used by the network users), a second setting section for, when a sender e-mail address and mail title are selected from the sender e-mail addresses and mail titles stored in the storage section, setting up the selected sender e-mail address in place of the sending station address (see at least abstract, ¶¶ (0019, 0042-0048, Figures 3,4; selecting user from the list of users in touch screen panel (shown in Fig. 3, 001 user nameA etc.) and by selecting the selected user, inputting user's e-mail address, IP address (name to be registered), password and storage holder name and registering the user (Fig. 4))), and a transmission control section for carrying out control for adding to the image data the sender e-mail address and the mail title set by the second setting section and transmitting the image data to the recipient address set by the first setting section (see at least ¶¶ (0047-0053), Figures 3, 4, 5; wherein e-mail transmission (52), PC transmission (53) (shown in Fig. 5) transmit scanning functions from the list of users from Fig. 3 etc.).

5. As to claim 2, Noda discloses a network scanner device as claimed in claim 1, further comprising a one-touch setting section (20)(Fig. 2) for setting up the recipient address and the sender e-mail address simultaneously (addressor registration control (21) and addressee registration control (22)) (Fig. 2).

6. As to claim 3, Noda discloses a network scanner device as claimed in claim 2, wherein the one-touch setting section carries out setting of the recipient address and the sender e-mail

address, in accordance with instructions by the sender (see at least **Fig. 2, addressor selection control and addressee selection control (24,25)**).

7. **As to claim 4**, Noda discloses a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient address and the sender e-mail address (see at least **Fig. 8 (Addressees List) and Fig. 10, list of Addressor user (100)**).

8. **As to claim 5**, Noda discloses a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender e-mail address are stored, wherein, on setting of the sender e-mail address, the recipient address is chosen from candidates of recipient addresses associated with the sender e-mail address (see at least **Fig. 6, e-mail transmission Address Book**).

9. **As to claim 6**, Noda discloses a network scanner device as claimed in claim 1, further comprising a storage section in which sender e-mail addresses associated with IDs representing users are stored, wherein the sender e-mail address is automatically set up in accordance with an inputted ID (see at least **Fig. 13, selecting user of addressee automatically selects the e-mail address registered with the user**).

10. **As to claim 7**, Noda discloses a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID

representing a user, as a condition for start of operations of the device (see at least ¶¶ (0046, 0047), Fig. 5).

11. **As to claim 8**, Noda discloses a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the sender e-mail address is inputted or chosen (see at least Fig. 12, input e-mail address of addressee/receiver and Fig. 13, select addressee from the list).

12. **As to claim 9**, Noda discloses a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender e-mail address can be inputted through the network (see at least Figures 1,12).

13. **As to claim 10**, Noda discloses a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see at least ¶¶ (0048, 0056)).

14. **As to claim 13**, Noda discloses an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data, the step of setting the recipient address to which the image data is to be transmitted, and the step of setting the sender e-mail address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see at least ¶¶ (0047-0053), Figures 3, 4).

15. **As to claim 14**, Noda discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by a user selection from addresses stored in the network scanner device in advance (see at least **Figures 3, 4**).

16. **As to claim 15**, Noda discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by an input of the sender e-mail address by a user (see at least ¶¶ (0047-0053)).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **UMAR CHEEMA** whose telephone number is (571)270-3037. The examiner can normally be reached on **M-F 8:30AM-5:00PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter A. Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./
Examiner, Art Unit 2444

/Djenane M Bayard/
Primary Examiner, Art Unit 2444